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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,467	03/27/2002	Howard D. Dean	28728-65	9628
21130 7590 06/16/2008 BENESCH, FRIEDLANDER, COPLAN & ARONOFF LLP ATTN: IP DEPARTMENT DOCKET CLERK 2300 BP TOWER 200 PUBLIC SQUARE CLEVELAND, OH 44114				
EXAMINER LAURITZEN, AMANDA L				
ART UNIT		PAPER NUMBER		
3737				
MAIL DATE		DELIVERY MODE		
06/16/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/089,467

Applicant(s)

DEAN ET AL.

Examiner

A. LAURITZEN

Art Unit

3737

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S509)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lang et al. (US 2003/0216669).

Lang et al. disclose a method and associated system for selecting an implant appropriately sized for an anatomical fit, the method including generating an image of defective and non-defective portions of hard tissue of interest (Fig. 1, in which defective cartilage is diseased and non-defective is the adjacent tissue). The CT images are segmented in that areas diseased areas are distinguishable from those that are adjacent [0041]. A base portion of a prosthetic device is considered a template, as it represents the normative shape effective to cover the defect of the cartilage overlaying the bone [0129]. Additionally, a library or catalogue of typically sized implants represent templates [0126]. An external shape of the implant is determined by manual or automatic shaping according to the imaged target site, and by component switching of modular implant pieces [0124], [0129]. A three-dimensional thickness map (depicted in Fig. 2) constitutes a volumetric image [0029]. Determining a position for seating the implant is implied in preparation of the implantation site and is necessary prior to performing the procedure. As the defective cartilage overlays the bone and the component template is shaped to cover the defective cartilage, the component template is effectively

"warped" around the external surface of the non-defective bone in the implant procedure [0129]. The library or catalogue of component implant pieces are utilized to determine a "normative shape" of additional hard tissue [0126]. It is additionally well known in the art to image the healthy joint in the case of a patient with one joint showing signs of degeneration and requiring an implant, in order to acquire "mirror images" of the complementary healthy joint by which to model the implant [0038]. It is also generally known to visualize a model of the implant over the implantation site [0075], [0084-85].

2. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ateshian et al. (US 6,126,690).

Ateshian et al. discloses or renders obvious a system and associated method for selecting an implant appropriately sized for an anatomical fit, making use of a model or template to visualize the region of interest, including healthy and diseased tissues. Additionally disclosed is imaging the complementary healthy joint to ascertain a mirror image of the site in its healthy and functional state (col. 1, lines 24-31; lines 36-45; lines 47-54; col. 2, lines 3-13; lines 15-20; lines 44-47; 61-67; col. 3, lines 1-54; col. 7, lines 33-52; col. 11, lines 24-39).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. LAURITZEN whose telephone number is (571)272-4303. The examiner can normally be reached on Monday - Friday, 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian L. Casler can be reached on (571) 272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. L./
Examiner, Art Unit 3737

A. LAURITZEN
Examiner
Art Unit 3737

/Brian L Casler/

Supervisory Patent Examiner, Art Unit 3737